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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,700	09/19/2003	James M. Mathewson II	RSW920030197US1	1988

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EXAMINER

LAI, ANNE VIET NGA

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,700

Applicant(s)

MATHEWSON ET AL.

Examiner

Anne V. Lai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6-10, 11, 16-20 are rejected under 35 U.S.C. 103(a) as unpatentable over **Chung** in view of **Shanahan** and/or further in view of **Ogasawara** (all previously provided) or **Catan** [US. 6,491,217].

In claims 1 and 11, Chung discloses a method and a system for preparing information susceptible to be used in theft detection using RFID technique, comprising:

providing for each item to be tracked an object smart tag (object RFID);

providing a check smart tag (check RFID) adhesively attached to a paper receipt when a transaction is processed for the item or a group of items;

wherein the object tag and the check tag, each having a memory for storing item-unique identification information for each item in machine-readable form ; and

wherein the machine-readable form is usable for subsequently detecting whether a collection of one or more items is identical to the one or more items processed in the transaction by comparing the item-unique identifying information in the machine-readable form to corresponding item-unique identifying information stored in an RFID

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tag affixed to each of the items in the collection (col. 1, l. 58-60; col. 3, l. 24-32; col. 4, l. 52-col. 5, l. 11, l. 57-65; col. 6, l. 10-18 ; unique identifier, col. 7, l. 15-23).

Chung states that the method and system can be applied to any system, process, or transaction, in which a smart tag is utilized (col. 3, l. 24-32) at a station that can read/write/issue smart tags (col. 4, l. 26-33) and alarm is generated if an additional unrelated smart tag is present (col. 6, l. 10-18). Therefore, it would have been obvious to an ordinary skill in the art at the time the invention was made the transaction station can be a point of sale and the check station can be the exit point of a store to detect unrelated smart tag for potential theft.

Chung does not disclose the tag is attached to an area separated from the printed area on the paper receipt; **Catan** teaches a RFID tag can be affixed to a receipt in an area separated from the area where the data is printed (figs. 3-5; col. 10, l. 51-63). Therefore it would have been obvious the RFID tag can be affixed to a printed receipt at a place of designer choice and especially not to cover the printed data because the printed data needs to be readable.

Shanahan supports the teaching of detecting theft at the exit store by scanning the RFID on the item and comparing the scanned result with a consumer's e-receipt (0051); and **Ogasawara** teaches that an e-receipt can be a printed receipt sent over a communication network or can be a smart IC tag presented to the purchaser at the checkout in conjunction with a conventional paper receipt (col. 3, l. 59- col. 4, l. 25; col. 8, l. 38-56; col. 9, l. 17-19).

In claims 6 and 16, **Chung** (col. 5, l. 57- col. 6, l. 18) and **Shanahan** (0051) teaches scanning a receipt for identifying information stored in a machine-readable form to reflect one or more items that were presented for purchase in a previous sales transaction; searching, in an RFID tag affixed to each or one or more items possessed by a shopper who also possesses the receipt, to locate corresponding identifying information for each possessed item; and concluding that selected ones of the items possessed by the shopper were not paid for if the identifying information located for the selected items is not detected by the scanning step. The identifying information of the item is unique as disclosed in **Chung** (col. 7, l. 15-23).

In claims 7 and 17, since the receipt of **Chung** combined containing an RFID tag affixed to a printed sales receipt, it would have been obvious scanning the e-receipt can be reading an electronic tag affixed to the printed sales receipt by virtue of its fast response by its communication ability.

In claims 8 and 18, **Chung** and **Ogasawara** disclose the item-unique identifying information read from an RFID tag affixed to the items presented for purchase is stored on the printed sales receipt at the time of purchase or transaction (**Chung**, col. 4, l. 62- col. 5, l. 11; **Ogasawara**, col. 8, l. 38-42), and **Shanahan** teaches issuing an e-receipt at purchase [0049] and verifying identification information of items and receipt at the store exit [0051].

In claims 9-10 and 19-20, **Chung** discloses the object smart tag and the check smart tag store item-unique identifier relating to history of the transaction with date and time (col. 7, l. 15-23), and history of transaction can be stored in the server database or

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at the smart tag reader associated with each electronic gate (col. 5, l. 48-56; col. 6, l. 32-35); therefore it would have been obvious an item can not be considered theft if the history of purchase can be verified at the entrance and exit of a shopping store.

3. Claims 2-5 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chung** combined in view of **Goodyear** [US. 2003/0089780].

In claims 2-3, 8, 12-13, 18, **Chung** discloses a printed paper label can contain the same information as is stored in the object smart tag, therefore the unique identifier stored in the smart tag is also printed on paper (col. 7, l. 43-51) however, **Chung** combined fails to disclose enumerated list of item-unique identifying information; **Goodyear** teaches that store enumerated list of item-unique identifying information on a printed sales receipt is well known (0002). Therefore it would have been obvious the paper receipt of **Chung** combined can contain an enumerated list of product unique identifier to facilitate the user in bookkeeping.

In claims 4-5 and 13-15, **Chung** discloses information in the memory of the smart tag and later be printed includes a smart tag serial number and a unique identifier relating specifically to the item (col. 7, l. 15-23, 43-51). **Ogasawara** teaches stock-keeping unit identifier can be shown on a receipt (PLU, SKU, UPC; fig. 4; col. 5, l. 9-67; col. 8, l. 33- col. 9, l. 15). **Goodyear** teaches that the item-unique identifier on printed sales receipt is used for accessing the shop database; therefore it would have been obvious to any one of ordinary skill in the art the item- unique identifier is an Electronic Product Code.

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4. The rejection to claims 21-25 are similar to the rejection to the method and the system for detecting theft of claims 1-5 and 11-15 with a reason that to make the system function automatically in a store equipped with computer, it would have been obvious to one having ordinary skill in the art at the time of the invention was made; a computer program product is obviously being implement.

5. The rejection to claims 26-30 are similar to the rejection to the method and the system for detecting theft of claims 6-10 and 16-20 with a reason that to make the system function automatically in a store equipped with computer, it would have been obvious to one having ordinary skill in the art at the time of the invention was made a computer program product is obviously being implement.

Response to Arguments

6. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

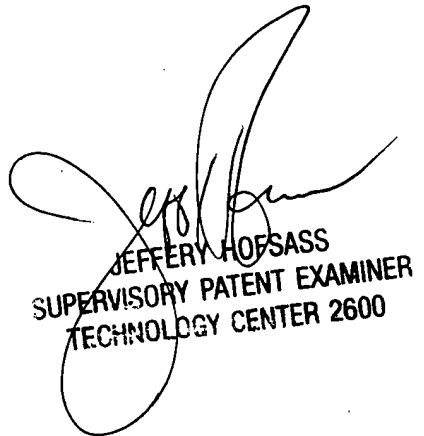
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne V. Lai whose telephone number is 571-272-2974. The examiner can normally be reached on 9:00 am to 6:30 pm, Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hofsass Jeffery can be reached on 571-272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AVL
10/27/06


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